

REMARKS


In response to the pending final Action, applicants filed a Fourth Supplemental Reissue Application Declaration and Power of Attorney on November 9, 2009, a copy of which is attached. Applicants believe this Declaration overcomes all of the outstanding rejections and Claims 1-20 are therefore in condition for allowance.

In view of the above, each of the claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **251002008830**.

Dated: December 8, 2009

Respectfully submitted,

By 

Adam Keser

Registration No.: 54,217
MORRISON & FOERSTER LLP
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McLean, Virginia 22102
(703) 760-7703

Attachment

Electronic Acknowledgement Receipt

| | |
|---|---|
| EFS ID: | 6418128 |
| Application Number: | 10691434 |
| International Application Number: | |
| Confirmation Number: | 2141 |
| Title of Invention: | Crystalline turbostratic carbon nitride powder and method for producing same DOCKETED |
| First Named Inventor/Applicant Name: | Osamu Miyagawa |
| Customer Number: | 25227 |
| Filer: | Johnathan Bockman/Kathleen Libby |
| Filer Authorized By: | Johnathan Bockman |
| Attorney Docket Number: | 251002008830 |
| Receipt Date: | 09-NOV-2009 <i>sh</i> |
| Filing Date: | 23-OCT-2003 |
| Time Stamp: | 16:05:34 |
| Application Type: | Utility under 35 USC 111(a) |

Payment information:

| Submitted with Payment | no | | | | |
|------------------------|----------------------|------------------|--|------------------|------------------|
| File Listing: | | | | | |
| Document Number | Document Description | File Name | File Size(Bytes)/ Message Digest | Multi Part /.zip | Pages (if appl.) |
| 1 | | 251002008830.pdf | 204696 <small>8a0b32e10e6cd03b0c490220f9950e03577e 8a07</small> | yes | 5 |

| Multipart Description/PDF files in .zip description | | |
|---|-------|-----|
| Document Description | Start | End |
| Miscellaneous Incoming Letter | 1 | 1 |
| Oath or Declaration filed | 2 | 5 |

Warnings:

Information:

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| Total Files Size (in bytes): | 204696 |
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
 If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.


National Stage of an International Application under 35 U.S.C. 371
 If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
 If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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|--|---|------------------------|------------------|
| <h1 style="text-align: center;">TRANSMITTAL FORM</h1> <p style="text-align: center;"><i>(to be used for all correspondence after initial filing)</i></p> | | Application Number | 10/691,434 |
| | | Filing Date | October 23, 2003 |
| | | First Named Inventor | Osamu YAMAMOTO |
| | | Art Unit | 1793 |
| | | Examiner Name | W. A. Langel |
| Total Number of Pages in This Submission | 5 | Attorney Docket Number | 251002008830 |

| ENCLOSURES (Check all that apply) | | |
|---|--|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <ul style="list-style-type: none"> FOURTH SUPPLEMENTAL REISSUE APPLICATION DECLARATION AND POWER OF ATTORNEY |
| <div style="border: 1px solid black; padding: 5px; height: 40px;">Remarks</div> | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | | |
|--|--|----------|--------|
| Firm Name | MORRISON & FOERSTER LLP | | |
| Signature |  | | |
| Printed name | Adam Keser | | |
| Date | November 9, 2009 | Reg. No. | 54,217 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
Osamu YAMAMOTO

Serial No.: 10/691,434

Filing Date: October 23, 2003

For: CRYSTALLINE TURBOSTRATIC
BORON NITRIDE POWDER AND
METHOD FOR PRODUCING SAME

Examiner: Wayne A. Langel

Group Art Unit: 1793

Confirmation No. 2141

**FOURTH SUPPLEMENTAL REISSUE APPLICATION DECLARATION
AND POWER OF ATTORNEY**

Mail Stop - AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name. I am the original, first and sole inventor of the subject matter that is described and claimed in U.S. Patent No. 6,306,358 B1, granted on October 23, 2001, and for which reissue is sought.

This declaration supplements the reissue declaration I executed on June 30, 2006. As explained in my prior declaration, my name has reverted to "Osamu Yamamoto," so I no longer request correction of my name on U.S. Patent No. 6,306,358 B1.

I affirmatively state that U.S. Patent No. 6,306,358 B1 is not assigned that and I am the sole owner of U.S. Patent No. 6,306,358 B1.

I believe the original patent to be wholly or partly inoperative or invalid by reason of claiming less than I had the right to claim in the patent. At least one error on which the reissue is based is described as follows: The original patent claims only a method of producing a crystalline turbostratic boron nitride, while the reissue application adds product claims directed to crystalline turbostratic boron nitride products. Accordingly, the scope of the claims has been broadened because a party could not necessarily be sued for infringement of the product based on the claims of the original patent if it were made by a method different from that originally claimed. The newly added claims should be considered broadening claims because the patent owner would be able to sue any party for infringement of the product claims who previously could not have been sued for infringement of the method claims.

It is my understanding that the addition of a claim in the reissue application that includes subject matter not covered by the patent claims enlarges the scope of the patent claims. The newly added claims in the reissue application are broader than the original claims because the newly added claims contain within their scope conceivable products which would not have infringed the original claims of the patent. A claim which covers something that the original claims do not is a broadened claim.

In the prosecution of the original patent my attorneys and I inadvertently failed to present claims directed to the crystalline turbostratic boron nitride products disclosed in Examples 6 and 7 of the specification. In particular, my patent attorneys and I inadvertently failed to claim crystalline turbostratic boron nitride products exhibiting the X-ray diffraction patterns depicted in FIG. 7 of this patent and explained at column 19, lines 18-37. The failure to claim this omitted subject matter resulted in my claiming less than I am entitled to claim in granted claims

1-6, which are erroneous because of this omission. New claims 7-20 are directed to that omitted subject matter.

All errors being corrected in this reissue application up to the time of execution and filing of this Declaration arose without any deceptive intent on my part.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment.

I acknowledge the duty to disclose information which is material to patentability in accordance with 37 C.F.R. § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

Application No. 9-21052 **Country** Japan

Filing Date 20/01/1997

POWER OF ATTORNEY

I hereby revoke all powers of attorney hereby given by me and appoint the attorneys and agents under Customer No. 25227 to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Please direct all communications to:

Barry E. Bretschneider
Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 400
McLean, Virginia 22102

Please direct all telephone calls to Barry E. Bretschneider at (703) 760-7743.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

November 2, 2009 Osamu Yamamoto

Date

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Citizenship: Japanese

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